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PATENT

Attorney Docket No.: SP01-095

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Bradford Giles Ackerman, et al.

Serial No: 09/844,947

Examiner: John Hoffman

Filing Date: April 27, 2001

Group Art Unit: 1731

Title: METHOD FOR PRODUCING  
TITANIA-DOPED FUSED  
SILICA GLASS

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**BRIEF ON APPEAL (2<sup>nd</sup> Revision)**

This Brief supports the appeal to the Board of Patent Appeals and Interferences from the final rejection dated March 29, 2005, in the application listed above. Applicant filed the Notice of Appeal on April 11, 2005 in accordance with 37 C.F.R. § 41.31. Applicant also has filed the appropriate petition and paid the required fee to gain an extension of the due date for filing this Brief to the Board. This Brief is submitted herewith in accordance with 37 C.F.R. § 41.37.

**I. REAL PARTY IN INTEREST**

The real party in interest in this appeal is Corning Incorporated, assignee of the entire interest in this application by virtue of an assignment recorded 08/21/2001 at

Reel/Frame 012100/0096.

~~11/15/2005 TBESHAM1 00000022 033325 09844947~~

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~~11/15/2005 TBESHAM1 00000022 033325 09844947~~

~~01 FC:1402 500.00 CR~~

## **II. RELATED APPEALS AND INTERFERENCES**

With respect to the appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal, there are no such appeals or interferences.

## **III. STATUS OF CLAIMS**

Claims 1, 2, 4-9, 13, 15, 20, 21, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Blackwell et al (5,152,819) in view of Flamembaum et al (3,806,570) and Roba et al (6,672,110). Claims 3, 10-12, 14, 16-19, and 22 have been previously cancelled or otherwise withdrawn from consideration.

A copy of the claims under appeal is attached in the appendix.

## **IV. STATUS OF AMENDMENTS**

The Amendment after Final Rejection filed on March 11, 2005 *has not been entered*.

By an Advisory Action dated March 29, 2005, the Examiner stated that the amendments are rejected on the grounds that (a) they raise new issues that would require further consideration and/or search, and (b) they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal. The Examiner's Note states that the amendment to claim 1 is rejected because the subject matter is being claimed for the first time. *Thus, for purposes of this Appeal the Amendment filed March 11, 2005 should be considered as not having been made due to the Examiner's rejection of the Amendment and statement that further prosecution would require an additional search. The claims presented herein are those that existed at the time the Final*

Office Action was issued

**V. SUMMARY OF CLAIMED SUBJECT MATTER**

The claimed invention relates to a method for producing a fused silica glass containing titania (a  $\text{SiO}_2\text{-TiO}_2$  glass).

Claim 1, the only independent claim, relates to a method for making a fused silica glass containing titania (page 2, lines 17-18). In the process, particles of silica and titania are synthesized by delivering their respective precursors to a deposition burner, and they exit the deposition where they react to form fine  $\text{SiO}_2\text{-TiO}_2$  particles (page 3, lines 3-5).

Subsequently, a column of a solid porous preform is grown by successively depositing the particles on a deposition surface at a temperature below a minimum temperature at which the particles can consolidate either partially or fully into dense glass (page 3, lines 8-10) while successively rotating and translating the deposition surface away from the burner (page 2, lines 18-21; and page 4, lines 15-24 and particularly lines 20-24; and Figure 1, numerals 36 (translation) and 38 (rotation). Finally, in a separate step the porous preform is consolidated into a dense glass (page 3, lines 6-10; and page 5, lines 16-19).

**VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

The claims are currently rejected by the Patent office as follows:

Claims 1, 2, 4-9, 13, 15, 20, 21, 23 and 24 are rejected under 35

U.S.C. §103(a) as being unpatentable over Blackwell et al. (U.S. Patent

No. 5,152,819) in view of Nakahara et al. (U. S. Patent No. 4,419,116),

Koide et al. (U.S. Patent No.) or Terashima et al. (U. S. Patent No. 5,423,898) and Roba et al. (U.S. Patent No. 6,672,110).

## **VII. GROUPING OF CLAIMS**

In compliance with 37 C.F.R. § 1.192(c)(5), Applicant states that all of the claims do stand or fall together. Claim 1 is the independent claim and claims 2, 4-9, 13, 15, 20, 21, 23 and 24 depend on claim 1 either directly or indirectly through another dependent claim.

## **VIII. ARGUMENTS**

### **General Comment**

Claim 1 states that the a column of a solid porous preform is grown by successively depositing the particles on a deposition surface at a temperature below a minimum temperature at which the particles can consolidate either partially or fully into dense glass while successively translating the deposition surface away from the burner. The background art (page 2, line 1) and the Detailed Discussion (page 5, lines 16-19) both indicate that consolidation temperatures are typically in the range of 1200-1900 °C, with a preferred range being 1300-1700 °C. The specification indicates on page 3, lines 8-10, that consolidating the glass in a separate step eliminates the need to capture the soot at consolidation temperatures and permits the soot to be captures at a lower temperature, typically 200-500 °C lower, than possible with the conventional boule process [in which the coot is captured at consolidation temperatures]. Using the foregoing information, one skilled in the art understands that these lower temperatures apply to the typical temperature range and the preferred temperature range as

mentioned in the foregoing sentence and the specification. This is not indicated in the cited art.

### **Claim Rejections Over The Cited Art**

The rejection of Claims 1, 2, 4-9, 13, 15, 20, 21, 23 and 24 as being unpatentable under 35 U.S.C. §103(a) as being unpatentable over Blackwell et al. (U.S. Patent No. 5,152,819) in view of Nakahara et al. (U. S. Patent No. 4,419,116), Koide et al. (U.S. Patent No.) or Terashima et al. (U. S. Patent No. 5,423,898) and Roba et al. (U.S. Patent No. 6,672,110) is improper.

In the final Office Action of January 25, 22005, the Examiner rejected pending claims 1, 2, 4-9, 13, 15, 20, 21, 23 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Blackwell et al. (U.S. Patent No. 5,152,819) in view of Nakahara et al. (U. S. Patent No. 4,419,116), Koide et al. (U.S. Patent No. 5,425,795) or Terashima et al. (U. S. Patent No. 5,423,898) and Roba et al (U.S. Patent No.6,67210). On page 2 of the Final Office Action, the Examiner stated that:

“Blackwell et al discloses a process for making an optical fiber glass preform. Silica precursor is mixed with a metal oxide dopant precursor, Ti oxide precursor and reacted in a soot burner to form soot. The soot is deposited on a rotating mandrel and subsequently consolidated in a He and Cl atmosphere. Blackwell is silent as to the minimum temperature of the soot deposition and the translation motion of the mandrel. Inherently the temperature during soot deposition is below the temperature at which the soot particles consolidate otherwise there would be solid fused glass instead of a soot preform. In any case, Roba et al teaches it is advantageous that the temperature of the soot preform during soot deposition be a temperature between 700 and 1200 °C. Note that Roba et al includes Ti doped soot preform, penultimate paragraph, column 5. It is also noted that “successively translating the deposition surface away from the burner”, is an obvious conventional feature of devices used to form the soot preform and of which Koide et al, Nakahara et al or Terashima et al are cited as evidence.”

Applicant respectfully submits that the Examiner failed to provide a *prima facie* case of obviousness because one of ordinary skill in the art would not be motivated to use or modify the teaching of Blackwell et al. in view of Roba et al. and the other cited art to obtain Applicant's invention. In re Vaeck, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991).

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992). The Examiner did not, and is unable, to point to any place in Blackwell et al., Roba et al., and other cited references where it suggests or provides a motive to modify the method described by Blackwell et al. to obtain the method described by Applicants. In particular, there is no specific teaching in any reference with regard depositing the soot on a "bait" or mandrel at a temperature below the consolidation temperature of the soot.

**First**, Blackwell et al. teach generating vapours and passing vapors through a burner flame to form a stream of volatile gases and finely-divided spherical particles of soot. Blackwell et al. teach collecting the soot on a mandrel or bait tube to form a porous preform. Blackwell et al. teach that the final product of soot collection, the porous preform, is then subjected to high temperature in which the preform consolidates into a nonporous monolithic glass body.

The Examiner admits that Blackwell et al. is silent as to the minimum temperature of the soot deposition. The Examiner has asserted that "inherently the temperature of soot deposition [in Blackwell et al.] is below the temperature at which the soot particles consolidate otherwise there would be solid fused glass instead of a soot preform." However, the terms "soot preform" and/or "porous preform" is not sufficient to establish the temperature at which the particles of soot were deposited. For example, particles of soot that

are only partially consolidated could be described as soot or porous preform. In fact, Applicants submit that Blackwell et al. indicate that in the process they describe, which uses CVD (chemical vapour deposition) to form the soot preform, there is partial consolidation of the preform during the deposition process. Blackwell et al., column 9, line 67, to column 10, line 3, reads:

“The resulting soot is deposited on a rotating rod 9, thus forming a preform or blank 10 of silica soot. The preform is then heat treated in a consolidation furnace 11, in a He/Cl atmosphere to full consolidation.”

The statement that the preform is heated to “full consolidation” clearly indicates that there is partial consolidation during the deposition process.

In contrast to Blackwell et al., Applicants state in claim 1, lines 5-7, that the particles (soot) formed are deposited on “. . . a deposition surface at a temperature below a minimum temperature at which the particles can consolidate either partially or fully into dense glass . . .” Thus, Applicants specifically teach that the preform is formed at a temperature at which there is no consolidation (partial or full) of the deposited particles [soot] into a glass.

**Second**, The Examiner combines Blackwell et al. with Roba et al., citing Roba et al. as teaching that it is advantageous that the temperature of the soot preform during soot deposition be a temperature between 700 and 1200 °C. Applicants submit that this combination does not render their invention unpatentable for being obvious over the combination of Blackwell et al. and Roba et al.

The method described by Roba et al. is completely different from the process of the present invention. In particular, the method of Roba et al. is a flame-free method that requires water as a reactant. Referring to Roba et al., Summary of the Invention:

(a) in column 2, lines 40-42, the method is described as being “. . . a hydrolysis reaction for producing an optical perform. . .”; and

(b) in column 2, lines 46-48, the hydrolysis reaction is described as being “. . . a flame-free hydrolysis, i.e., a reaction in which the process temperature can be precisely controlled, as opposed to convention flame-hydrolysis . . .”; and

(c) in column 2, lines 60-61, the method is stated as comprising one requiring a “. . . first gaseous or vapour phase composition disposed to provide a hydrolyzable glass precursor . . .”, and in column 2, lines 63-64, “supplying water as a second gaseous or vapour phase composition . . .”

Applicants submit that this method is completely different from the methods described by Applicants in their specification. Applicants further submit that the 700-1200 °C temperature range described by Roba et al. and cited by the Examiner is peculiar to the method they claim and is the result of a temperature gradient that they provide within the reaction chamber as described in column 3, lines 5-8, “. . . characterized in that a temperature gradient is provided inside of said [reaction] chamber, said temperature gradient being such that the temperature increases from said inlet zone to said outlet of the reaction chamber.” Referring to Roba et al. Figure 3, the gradient is believed provided by the element represented by numeral 30 (*which numeral is not mentioned in the specification*), which seems similar to the electrical resistance heater 37 described in column 7, lines 9-13.

**Third**, the Examiner cites Nakahara et al. (U. S. Patent No. 4,419,116), Koide et al. (U.S. Patent No. 5,425,795) or Terashima et al. (U. S. Patent No. 5,423,898) for teaching the “successive translating the deposition surface away from the burner.” Applicants have reviewed these patents and comment that while Terashima et al. do not teach either the formation of any preform nor rotation. Terashima et al. Nakahara et al. (U. S. Patent No. 4,419,116) and Koide et al. (U.S. Patent No. 5,425,795) do teach rotation of the bait rod during formation of the preform, but the disclosure therein does not render Applicants’



method obvious when combined with Blackwell et al. and Roba et al. The fact that Tereshima et al., Nakahara et al. and Kiode et al. teach an element of the Applicants' invention is not sufficient to make it obvious when other elements of Applicants' invention such as depositing the soot below consolidation (partial or full) temperature is not disclosed in the other art with which Tereshima et al., Nakahara et al. and Kiode et al. are combined.

The U.S. Court of Appeals for the Federal Circuit has stated that the Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness and in the case of combined references, the Examiner can satisfy this burden "only by showing some objective teaching in the prior art . . . would lead that individual to combine the relevant teachings of the references." In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Moreover, both the suggestion and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure. In re Vaeck, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991).

Cited references should not be considered in a vacuum, but against the background of the references as a whole. "The question in a §103 case is what the references would collectively suggest to one of ordinary skill in the art." In re Ehrreich, 200 U.S.P.Q. 504, 509-10 (C.C.P.A. 1979). If the collective references indicate that those skilled in the art would ignore statements as speculative, then those statements cannot be considered teachings for purposes of an obviousness rejection. Id.; In re Oelrich, 198 U.S.P.Q. 210, 214 (C.C.P.A. 1978). In the instant case, as discussed above, the primary reference of Blackwell et al. does not teach or suggest a critical feature of the claimed invention; namely, deposition of soot below consolidation temperature. This feature is not supplied by the secondary reference of Roba et al or the additional references of Nakahara et al., Koide et al. or Terashima et al.

Consequently, Applicants submit that not only did the Examiner fail to meet his burden of establishing a *prima facie* case because one of ordinary skill in the art would lack the motivation to modify Blackwell et al.; but he failed to meet that burden because one skilled in the art would not find Applicants' method when Blackwell et al. is combined with Roba et al., Nakahara et al., Koide et al. and Terashima et al. Accordingly, one skilled in the art would not reasonably expect to successfully arrive at Applicant's claimed invention by combining the primary and secondary references.

#### IX. CONCLUSION

In conclusion, Applicant requests a reversal of each of the grounds of rejection maintained by the Examiner.

Please charge the necessary fees of \$500 for filing the Brief on Appeal to our Deposit Account No. 03-3325. If there are any other fees due in connection with the filing of this Brief on Appeal, please charge the fees to our Deposit Account No. 03-3325. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

Dated: 4 November 2005

By: Walter M. Douglas

Walter M. Douglas  
Registration No. 34,510  
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Corning Incorporated  
Patent Department  
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**CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8:**

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Date of Deposit

Walter M. Douglas 4 November 2005  
Walter M. Douglas

## **APPENDIX TO BRIEF ON APPEAL**

The claims on appeal are as follows. Claim 1 is shown with the amendment submitted in response to the Final Office Action.

### **Listing of Claims:**

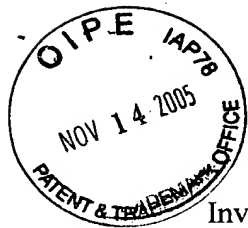
1. (rejected) A method for producing a fused silica glass containing titania, comprising:
  - synthesizing particles of silica and titania by delivering a mixture of silica precursor and a titania precursor to a burner;
  - growing a column of solid porous preform by successively depositing the particles on a deposition surface at a temperature below a minimum temperature at which the particles can consolidate either partially or fully into dense glass while successively translating the deposition surface away from the burner; and
  - subsequently consolidating the porous preform into dense glass.
2. (rejected) The method of claim 1, wherein a translation speed of the deposition surface is adjusted to maintain a substantially constant distance between an end portion of the porous preform remote from the deposition surface and the burner during deposition.
3. (previously cancelled)
4. (rejected) The method of claim 1, wherein consolidating the porous preform into dense glass comprises heating the porous preform to a temperature in a range from 1200 to 1900°C.
5. (rejected) The method of claim 1, further comprising dehydrating the porous preform by exposing the porous preform to a heated, halide-containing atmosphere prior to consolidation.

6. (rejected) The method of claim 5, where in the heated, halide-containing atmosphere comprises chlorine.
7. (rejected) The method of claim 5, where in the heated, halide-containing atmosphere comprises fluorine.
8. (rejected) The method of claim 5, wherein the temperature of the heated, halide-containing atmosphere is in a range from 900 to 1100°C.
9. (rejected) The method of claim 1, wherein the glass contains 2 to 12% by weight titania.
10. – 12 (previously cancelled)
13. (rejected) The method of claim 5, wherein a translation speed of the deposition surface is adjusted to maintain a substantially constant distance between an end portion of the porous preform remote from the deposition surface and the burner during deposition.
14. (previously cancelled)
15. (rejected) The method of claim 5, wherein consolidating the porous preform into dense glass comprises heating the porous preform to a temperature in a range from 1200 to 1900°C.
16. – 19. (previously cancelled)
20. (rejected) The method of claim 1, wherein the minimum temperature is approximately 1200°C.

21. (rejected) The method of claim 20, wherein the temperature at which the particles are deposited is approximately 200 to 500°C less than the minimum temperature.

22. (previously cancelled)

23. (rejected) The method of claim 1, wherein a variation on coefficient of thermal expansion of the dense glass is in a range from -5 ppb/°C to +5 ppb/°C.



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Sir:

The attached revised Brief is in response to the Office Communication dated October 19, 2005 informing us that we filed a Non-Compliant Appeal Brief under 37 C.F.R. §41.37.

If there are any other fees due in connection with the filing of this Brief on Appeal, please charge the fees to our Deposit Account No. 03-3325. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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